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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,202	02/01/2001	Johnny B. Corvin	UV-181	7104

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EXAMINER

BELIVEAU, SCOTT E

ART UNIT PAPER NUMBER

2614

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/775,202

Applicant(s)

CORVIN ET AL.

Examiner

Scott Beliveau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-18,35,36 and 38-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-18,35,36 and 38-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/24/05 + 5/16/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Priority***

1. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

However, the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 2, 8, 11, 14-18, 36, 41, 44, and 46-48 of this application as follows:

- The provisional application fails to suggest that the "promotion is selected based upon the content of the program" as recited in claims 2 and 36;
- The provisional application fails to provide adequate support for "recording a flag with the promotion to indicate the beginning of the program during playback" as recited in claims 8 and 41;
- The provisional application fails to suggest that the "promotion is recorded at any desired point within the program" recited in claims 11 and 44;
- The provisional application fails to provide support for the particular method of distribution of the program, the promotion, and the program guide over either a "single broadcast channel" or a "plurality of broadcast channels" as recited in claims 14, 15, 46, and 47;
- The provisional application does not disclose details regarding the storage of the program, the promotion, and the program guide data with a "storage unit" or a "plurality of storage units", as recited in claims 16, 17, and 48.

### ***Information Disclosure Statement***

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2. The information disclosure statements (IDS) submitted on 24 February 2005 and 16 May 2005 were filed after the mailing date of the Non-Final Rejection on 25 August 2004. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Drawings***

3. The drawings received on 01 February 2001 are approved in light of the amendment to the specification.

### ***Response to Arguments***

4. Applicant's arguments filed on 24 February 2005 have been fully considered but they are not persuasive.

With respect to applicant's arguments pursuant to the grounds of rejection under Arai such that the reference fails to teach or suggest selecting a promotion to record, the examiner respectfully disagrees. As noted by applicant, the Arai provides the ability for a user to select whether or not to record commercials. It is the examiner's interpretation that in designating whether or not to record commercials with the program that the user/apparatus is also implicitly choosing or "selecting promotions to record" or those associated with the broadcast program. The rejected claims do not require that the recorded promotions are anything other than those associated or already pre-determined to be broadcast with the individual television program.

With respect to applicant's arguments that there is no suggestion to combine the Young et al. and Zigmond references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as previously set forth in the grounds of rejection, the particular motivation to modify Young et al. is found in the Zigmond reference. Young et al. teaches a method for selecting, watching, and recording television programs. Zigmond teaches that it is desirable to insert custom advertisements into television programs and that advertisements can be recorded. Accordingly, taken in combination, a viewer that watches a program and further records that program will also record customized or selected promotions directed towards the individual or household.

For example, taken in combination, assume person "A" watches a television program and also decides to record the program for either future viewing by himself or for person "B" who is not planning to be present for the original broadcast. The combined teachings would subsequently select a customized promotion for person "A" which would subsequently be recorded. At a later point in time, this previously selected and recorded promotion may be substituted on playback depending upon the playback conditions (ex. who is watching, when is it being watched, etc.).

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 4-6, 12-18, 35, 38, 39, and 45-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Arai et al. (US Pat No. 6,486,920).

In consideration of claims 1, 4, 5, 35, 38, and 39, the Arai et al. reference discloses a “system” and “method for providing promotions with recorded programs” wherein both a “program” or movie and a “promotion” are “selected . . . to record” via a “processor” [100] (Figure 44) wherein the “selecting of the program is based on user input” of a “specific program” or “program designation” (ex. title) (Figure 34). Subsequently, both forms of content are “caused . . . to be recorded” and are “caused” to be “presented during a playback of the program” as directed by a “user input device that receives user input” [9] (Col 10, Lines 39-42; Col 16, Line 11 – Col 17, Line 27).

Claim 6 is rejected wherein the method further comprises “recording both the program and the promotion on a storage unit” [20] (Figure 44).

Claims 12, 13, 16-18, 45, and 48 are rejected wherein the method further comprises “receiving the program and the promotion” and “program guide data” and subsequently “storing” them on a “storage unit” comprising a “plurality of storage units” [2/20]

Claims 14, 15, 46, and 47 are rejected wherein the “program, the promotion, and the program guide data are received” either via a “single broadcast channel” or via a “plurality of broadcast channels” (Col 15, Lines 30-46).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
9. Claims 1, 2, 4-18, 35, 36, and 38-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. (US Pat No. 5,353,121) in view of Zigmond et al. (US Pat No. 6,698,020).

In consideration of claims 1, 3, 5, 35, 38, and 39, the Young et al. reference discloses a “system” and “method” for “selecting” wherein the “selecting of the program is based on user input” of a “specific program” or “program designation” (ex. title) (Col 10, Lines 29-41)

and “causing” a program to be recorded under to instructions of a “processor” [228] and a “user input device that receives user input” [212] (Col 19, Lines 13-28). The reference, however, does not explicitly disclose nor preclude the further “selection”, “recording”, and “playback” of a “promotion” in conjunction with the recorded program.

The Zigmond et al. reference discloses a “system” and “method for providing promotions with recorded programs” comprising “selecting a promotion to record” and “causing the program and the promotion to be recorded” and subsequently “causing the promotion to be presented during a playback of the program” (Col 14, Lines 1-12). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to combine the Young et al. program selection and recording teachings in conjunction with the promotion insertion and recording teachings of Zigmond et al. for the purpose of providing a means to specifically target, deliver, and present individually targeted advertisements to viewers regardless of the source of the media in order to effectively reach the consumer (Zigmond et al.: Col 3, Line 45 – Col 4, Line 3).

Claims 2 and 36 are rejected wherein the “promotion is selected based upon the content of the program” (Zigmond et al.: Col 12, Line 60 – Col 13, Line 6).

Claim 6 is rejected wherein the method further comprises “recording both the program and the promotion on a storage unit” [207] or VCR.

In consideration of claims 7 and 9-11, the Zigmond et al. reference discloses that “promotions” may be displayed either so as to replace existing advertisement slots or may be placed at any point in the programming. Accordingly, during the recording of such a program a promotion would be “recorded” at the “beginning of the program”, the “end of the

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program”, the “beginning and the end of the program”, or “at any desired point within the program” (Zigmond et al.: Col 14, Lines 1-12; Col 16, Lines 20-43). Similarly, the playback of the aforementioned recorded media may have commercials “integrated” at different points in time.

Claims 8 and 41 are rejected wherein the Young et al. reference is operable to “record a flag . . . to indicate the beginning of the program during playback” so as to locate the beginning of a particular program (Col 19, Lines 46-61).

Claims 12, 13, 16-18, 45, and 48 are rejected wherein the method further comprises “receiving the program and the promotion” and “program guide data” and subsequently “storing” them on a “storage unit” comprising a “plurality of storage units” (Zigmond et al.: Figure 5; Col 12, Line 60 – Col 13, Line 6; Col 14, Lines 1-12; Col 15, Lines 24-34).

Claims 14, 15, 46, and 47 are rejected wherein the “program, the promotion, and the program guide data are received” either via a “single broadcast channel” or via a “plurality of broadcast channels” (Zigmond et al. Col 7, Lines 1-25; Col 14, Line 66 – Col 15, Line 16)(Young et al.: Col 18, Lines 37-55).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until

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after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 571-272-7343. The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SEB  
June 19, 2005

  
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